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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,018	09/23/2005	Tadayuki Kurihara	276721US3PCT	3763
22850 7590 11/24/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER TRAN, BINH X	
			ART UNIT 1792	PAPER NUMBER
			NOTIFICATION DATE 11/24/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/550,018	<b>Applicant(s)</b> KURIHARA, TADAYUKI	
	<b>Examiner</b> Binh X. Tran	<b>Art Unit</b> 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/23/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-3, the term “chip-like” (emphasis added, occur plurality of times) is subjective, vague and indefinite. It is unclear from the claim what specific structure that applicants consider as “chip-like”.

In claim 1 line 5, the term “lattice-like” is subjective, vague and indefinite.

In line 5-7 of claim 1, “slitting said first multi-layer coat in a lattice-like pattern and to a depth corresponding to thickness of said first multi-layer coat to divide same into square subdivisions” (emphasis added) is indefinite. It is unclear from the claim what specific layer and/or structure that the term “same” is refer to.

Claims 2-3 are indefinite because they depend on indefinite claim 1.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawai (JP 2002-323617) in view of Connell et al. (US 2003/0162368).

Respect to claim 1, Kawai disclose a method for manufacture coated chip optical parts comprising:

coating a first layer multi-layer coat (4) on a first coat depositing surface on one side of a thickened substrate (1) (Fig 6, paragraph 0017, 0020, 0024);

slitting said first multi-layer coat (slitting 2) in a lattice pattern and to a depth corresponding to thickness of said first multi-layer coat to divide the first multi-layer into square subdivisions in a unit size of a coated chip optical parts, wherein the slitting certainly create deformation and damages caused by the stress (Fig 2, Fig 5c, paragraph 0020-0022);

deposit a second multi-layer (3) coat on a second coat depositing surface (Fig 6d, paragraph 0016, paragraph 0020-0022);

cutting said substrate material into unit of coated chip optical parts of ultimate products (Fig 6e, Fig 8, Fig 4);

wherein the thickened substrate being initially allotted with a sufficient thickness to prevent deformation caused by depositing of said first multi-layer coat (paragraph 0012-0014).

Kawai fails to disclose the step of grinding a surface on the other side of said thickened substrate to obtain a parental substrate material having a reduced thickness. Connell teaches to grind a surface on the other side of the thickened substrate to obtain a substrate material of a reduced thickness (See Fig 7, paragraph 0017, 0057-0056).

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Connell further disclose that the first layer (40) create a stress in the wafer (paragraph 0053, 0056). Therefore, the step of grinding to a reduce thickness certainly capable of reducing deformation and damages caused by stress imposed by slitting subdivisions of the first layer. It would have been obvious to one having ordinary skill in the art, at the time of invention, to modify Kawai in view of Connell by grinding a surface of the other side of the substrate because it help to thin the substrate and preventing the dice warp (paragraph 0017).

Respect to claim 2, Kawai discloses the first and second multi-layer are different materials with different function, therefore they must be different form each other in optical properties (paragraph 0016-0017). Respect to claim 3, Kawai both first (4) and second (3) multi-layer coats are optical multi-layer coats (paragraph 0016-0017), said second optical multi-layer (3) being deposited in a number of layers (100-200 layers, See paragraph 0016) suitable for cancel stress and adapted to generate aimed optical properties in cooperation with the first multi-layer coat (See paragraph 0019, 0021, 0022-0025).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh X. Tran whose telephone number is (571) 272-1469. The examiner can normally be reached on Monday-Thursday and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Binh X Tran  
Primary Examiner  
Art Unit 1792

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